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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,768	03/11/2004	Clifford L. Smith		6437

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LAW OFFICE OF CRAIG BOHN
2134 BRANARD STREET
HOUSTON, TX 77098

EXAMINER

TUROCY, DAVID P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,768

Applicant(s)

SMITH, CLIFFORD L.

Examiner

David Turocy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/31/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments and amendments, filed 1/27/05, have been fully considered and reviewed by the examiner. In light of the amendments and the filing of a new oath, the rejections to the claims and the objection to the oath or declaration have been withdrawn by the examiner. The examiner acknowledges the cancellation of claims 17-25. Claims 1-16 are pending.
2. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations to the claims have narrowed the thickness of the plated layer to be greater than 150 microns. However, there is no basis for such a range in the specification. The lower endpoint of 150 microns for the

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plating thickness is not taught in the specification and thus is considered to be new matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6073648 by Watson et al ("Watson") in view of US Patent 4889602 by Oshima et al ("Oshima") and further in view of the admitted state of the art as taught from the applicants' description.

Claims 1-3, Watson discloses coating equipment with an electroplated layer with corrosive resistant material (Column 1, lines 23-25, Column 2, lines 38-46, Figure 1). Watson discloses applying an electroplated layer with a thickness greater than 0.06 inches, or 1524 microns, with a specific range of 0.0001 to 0.04 inches or 2.5 microns to 1016 microns (Column 2, lines 58-63). After electroplating, Watson discloses applying an overcoat by spraying (Column 4, lines 61-64).

Watson fails to disclose the plating layer have a thickness greater than 150 microns. However, in the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05.

Watson fails to teach applying an electroplating layer containing nickel. However, Oshima teaching of an electroplating bath, discloses a zinc-nickel alloy electroplated layer on metallic articles is known in the art to improve the corrosion resistance properties (Column 1, lines 19-22).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Watson to use the zinc-nickel electroplated layer as suggested by Oshima to provide a desirable corrosion resistant coating on a metallic article because Oshima discloses zinc-nickel alloy electroplated layer on metallic articles is known in the art to improve the corrosion resistance properties and therefore would reasonably be expected to effectively provide corrosion resistance for equipment parts.

Watson in view of Oshima fails to teach of a preparing the tool service area. The admitted state of the art as taught from the applicants description teaches that the "typical plating process consists of preparation of the item to be plated" which may include one or more of cleaning, grinding, stripping, polishing, blasting, and baking (Background of Invention, pg 2, lines 7-20).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to include a preparation step before plating including such steps as cleaning and abrading the tool service area with the expectation it helps improve adhesion of layer.

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Claims 4-6 and 8, Watson in view of Oshima is discussed above. Watson in view of Oshima fails to teach of a transitional finishing step at the end of the plating process. The admitted state of the art as taught from the applicants description teaches that typical plating is post-plate finished which may include one or more of cleaning, grinding, polishing, super-finishing, blasting, baking, and inspection (Background of Invention, pg 2, lines 7-20).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to include a transitional finishing step including abrading, baking and a transitional evaluating step.

Claims 7 and 11, Watson in view of Oshima is discussed above. Watson in view of Oshima fails to teach of subsequent plating step or a subsequent spraying step.

It is the examiners position that it would have been obvious to one skilled in the art at the time of the invention to apply multiple plating or spraying layer with the expectation of creating a thicker coating to, provide a more durable coating and meet any thickness requirements. Additionally, the admitted state of the art teaches that multiple layers of spray coating may be applied to create a desired thickness (Background of Invention, pg 3 lines 16-18).

Claims 9, 10, and 12-16, Watson in view of Oshima is discussed above. Watson in view of Oshima fails to teach of finishing steps at the end of the spraying process. The admitted state of the art as taught from the applicants description teaches that

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typical spraying is post-spray finished with one or more of cleaning, grinding, polishing, super-finishing, blasting, baking, and inspection (Background of Invention, pg 2 lines 21-23, pg 3 lines 1-18).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to include a conventional transitional finishing step including abrading, baking and inspecting the layer. Additionally, it would have been obvious to one skilled in the art at the time of the invention to include a finishing step after the spraying step that includes cleaning, polishing, and evaluating.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy
AU 1762



TIMOTHY MEEKS
PRIMARY EXAMINER